

REMARKS

Claims 16-30 are still pending. No amendments to the claims have been made.

Response to 35 U.S.C. 103(a) rejection

Claims 16-30 remain rejected by the examiner as being obvious over Fänger et al. (U.S. Patent 6,153,204) in view of Msika et al. (U.S. Patent 5,939,054). However, the examiner's responses do not adequately address the applicants arguments.

The applicants' previously argued that "The examiner appeared to acknowledge that Fänger et al. does not teach the inclusion of at least one modified phyllosilicate pigment particle which have amphiphilic character." The examiner's response in the final rejection did not refute this statement and as such there is no prima facie case for obviousness using the Fänger et al. and Msika et al. references in combination (even if it were permissible to "pick and choose" elements out of the teachings of Msika et al., there is no teaching or suggestion from either reference to make such a substitution to arrive at the applicants invention).

(In the office action section entitled "103 Rejection Maintained" there are five paragraphs which begin with "Applicant argues": Numbers in parenthesis below correspond to applicants response to examiner's counterarguments)

- (1) The applicants argument was that the teachings of Fänger et al. did not teach limitations a) and d), i.e. there is no teaching of a preparation which simultaneously has an oil phase which comprises from 10 to 70% by weight, based on the weight of the oil phase, or fatty and/or wax components which melt above a temperature of 40° C AND at most 0.5% by weight, based on the total weight of the preparations, of one or more emulsifiers.
- (2) The passage referred to by the examiner (col. 2, lines 32-34) is for an W/O lipodispersion. This is not the same as a W/O emulsion. The examiner is directed to the teachings immediately preceding this passage (see col. 2, lines 17-22 which is reproduced below):

" Hydrodispersions are dispersions of a liquid, semi-solid or solid internal (discontinuous) lipid phase in an external aqueous (continuous) phase.

However, *in contrast to O/W emulsions*, which are distinguished by a similar phase arrangement, *hydrodispersions are essentially free from emulsifiers.*"

As such, the state of the art teaches that it is normally expected that a W/O emulsion would have an emulsifier and the examples of Fänger et al. would lead one of ordinary skill in the art to use an amount of emulsifier which is well in excess of that which is claimed by the applicants.

- (3) As stated above, one of the elements of the applicants invention which has not been disclosed is that Fänger et al. does not teach the inclusion of at least one modified phyllosilicate pigment particle which have amphiphilic character." Fänger et al. generically refer to the use of thickeners for gels (which is not specifically taught to be a W/O emulsion).

If Msika et al. is relied upon for use of other thickeners, there is no motivation to make such a substitution and given that the applicants claim state that their modified phyllosilicate pigment particles positions itself at the water/oil interface, there is no explanation or reasons given by the examiner as to why one of ordinary skill in the art would:

- (1) select the specific hectorites used in Msika et al. while disregarding the remainder of the "as a whole" determination of their invention;
- (2) have a reasonable expectation that such a substitution could be made given the differences between the compositions of Fänger et al. and Msika et al.;
- (3) be motivated to make such a substitution when the primary reference Fänger et al. teaches the use of thickeners for gels (which does not necessarily have to be a W/O emulsions).

The applicants previous arguments assert that there would be no motivation for making the substitution of the teaching of Msika et al. into that of Fänger et al. for the reasons of the applicants invention. If there is an alternative motivation different from that of the applicants, it has not been developed based on a factual based inquiry or the standards for asserting motivation, i.e. The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of a

problem to be solved. The motivation also may be implicit from the prior art as a whole, rather than expressly stated in the references. However, whether the USPTO relies on an express or an implicit show of motivation, **it must provide particular findings related to its conclusions, and the showing must be clear and particular.** Broad conclusionary statements standing alone are not "evidence". see *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

- (4) If Msika et al. was not relied upon as argued by the applicants in the previous response, then the examiner has not established that the combination of Fänger et al. and Msika et al. teach a preparation which contains an oil phase which comprises from 10 to 70% by weight, based on the weight of the oil phase, of fatty and/or wax components **which melt above a temperature of 40° C.**
- (5) The examiner stated that Msika et al. was relied upon as a secondary reference for their teachings of specific hectorites. However, given the established differences between the applicants' invention, the teachings of Fänger et al. and the teachings of Msika et al., the examiner has relied upon improper "picking and choosing" to select this particular element from the Msika et al. reference for combination with Fänger et al.

It has previously been held that **"[i]t is impermissible** within the framework of section 103 **to pick and choose** from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965))

More recently, it has been held that **"... 'Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.'"** see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of invention, to look to particular sources, to select particular elements, and to combine them as combined by the

inventor. see *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d 546, 48 USPQ2d 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, **the prior art must provide a suggestion or motivation** to make such a combination.") see *Crown Operations Int'l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

Moreover, if the examiner was relying on Msika et al. only for the teaching of hectorites, then there was never a basis for establishing that the combination of Fänger et al. and Msika et al. would result in the applicants claimed preparations which have at most 0.5% by weight of an emulsifier (as in claim 16) or that the preparation is emulsifier free (as in claim 17)

(Note: The examiner repeated her paragraph about "Unexpected Results" in her final rejection and as such this cannot be dismissed as a typographical error. It still remains unclear as to the purpose of this paragraph as there is no requirement that unexpected results need be shown for patentability. Furthermore, even if a *prima facie* case of obviousness had been established by the examiner, a showing of unexpected results is not the only means by which an applicant can overcome such a holding. If there is some other argument, position or suggestion for comparative testing that the examiner is/was trying to establish, it was not immediately clear to the applicants during prosecution of this application.)

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (6 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: **25 November 2002**

By: 

Vilma I. Fernandez